UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,046	01/25/2002	Katsumi Kanasaki	RCOH-1044	3429

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EXAMINER
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ART UNIT	PAPER NUMBER
2141	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/057,046	KANASAKI, KATSUMI
	Examiner	Art Unit	
	RANODHI N. SERRAO	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 February 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-22* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some *   c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12

February 2008 has been entered.

Response to Arguments

2.   Applicant's arguments with respect to claims 1-22 have been considered but are

moot in view of the new ground(s) of rejection.

3.   Applicant argued,

> Although the applicant believes that the new address definition includes a new
> address, for the sake of advancing prosecution, the applicant has further
> elucidated the patentable feature of the current invention as the Examiner has
> implied.

4.   The examiner points out that the specification does not support applicant's newly

added and prior limitations. Particularly the limitation, <u>automatically generating a new

address definition including a new address</u>, is not disclosed. Therefore the claims are

rejected under 112, first paragraph as shown below. Furthermore, the applicant did not

attempt to point out which sections of the specification relate to these limitations. For the

purposes of examination, the limitations have been incorporated into the claims,

however the limitation, "a new address" is interpreted as a new address definition.

Therefore the cited prior art teach these added features. The remainder of applicant's

arguments is directed to the newly added limitations which have been addressed.

5.　　　The examiner points out that the pending claims must be "given the broadest

reasonable interpretation consistent with the specification" [In re Prater, 162 USPQ 541

(CCPA 1969)] and "consistent with the interpretation that those skilled in the art would

reach" [In re Cortright, 49 USPQ2d 1464 (Fed. Cir. 1999)]. In conclusion, upon taking

the broadest reasonable interpretation of the claims, the cited references teach all of the

claimed limitations. And the rejections are maintained.

Specification

6.　　　The specification is objected to as failing to provide proper antecedent basis for

the claimed subject matter.　See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).　Correction

of the following is required: The below mentioned limitations of claims 1, 12, 21, and 22

are not supported in the applicant's specification. See below rejection.

Claim Rejections - 35 USC § 112

7.　　　The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8.　　　Claims 1, 12, 21, and 22 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the written description requirement.　The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention. The instant application's

specification does not disclose the limitation of, <u>automatically generating a new address</u>

<u>definition including a new address</u>. Neither can the examiner find nor has the applicant

pointed out where this limitation is taught in the disclosure. There is no mention in the

specification of automatically generating a new address definition much a new address

definition that includes a new address. The only mention of automatically performing a

step is in ¶ 2, however this does not relate to claimed limitations. Therefore the claims

fail to comply with the written description requirement.

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

10.   Claims 1, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

11.   Claim 1 recites, "a new address" multiple times in lines 7 and 8. Further in line

13, the claim recites, "the new address." It is vague and unclear which one of the new

addresses "the new address" refers to. Furthermore the claim recites, **requesting** an

address definition **from a second device** to a first device. Then recites, **returning** the

address definition containing a plurality of components to the second device **from the**

first device. Emphasis added. If an address definition is requested from a second

device, it should be returned from the second device not the first. The examiner fails to

see how the address definition can be returned from the first device when the first

device is requesting the address definition from the second device. This does not make

logical sense. Therefore the claim is vague and indefinite.

12.   Claims 21 and 22 recite similar language in regards to requesting an address

definition. Therefore these claims are rejected as being indefinite.

Claim Rejections - 35 USC § 101

13.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

14.   Claims 21-22 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. When nonfunctional descriptive material is

recorded on some computer-readable medium, in a computer or on an electromagnetic

carrier signal, it is not statutory since no requisite functionality is present to satisfy the

practical application requirement. There is no mention in the applicant's specification

what "a computer readable medium" consists of.

15.   The claimed invention as a whole must be useful and accomplish a practical

application. That is, it must produce a "useful, concrete and tangible result." State

Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is

to limit patent protection to inventions that possess a certain level of "real world" value,

as opposed to subject matter that represents nothing more than an idea or concept, or

is simply a starting point for future investigation or research (Brenner v. Manson, 383

U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76

USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d

1600, 1603-06 (Fed. Cir. 1993)).

Claim Rejections - 35 USC § 103

16.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

17.   Claims 1, 2, 12, and 22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Holleran et al. (5,752,059) and Taylor et al. (5,754,306).

18.   As per claim 1, Holleran et al. teaches a method of flexibly managing addresses

for a communication system (see Holleran et al., col. 3, lines 26-52), comprising the

steps of: requesting an address definition from a second device to a first device;

returning the address definition containing a plurality of components to the second

device from the first device (see Holleran et al., col. 5, lines 40-64); obtaining a

corresponding predetermined rule definition for the address definition to generate a new

address (see Holleran et al., col. 8, lines 1-20); automatically generating a new address

definition including a new address based upon the corresponding predetermined rule

definition at the second device (see Holleran et al., col. 8, lines 46-65); and returning the

newly generated address definition including the new address from the second address

to the first device (see Holleran et al., col. 9, lines 13-23). But fails to teach generating a

new address definition based upon the corresponding conditions at the second device,

the newly generated address definition including some components based upon the

corresponding predetermined rule definition and the corresponding conditions.

However, Taylor et al. teaches automatically generating a new address definition based

upon the corresponding predetermined rule definition and corresponding conditions at

the second device (see Taylor et al., col. 23, line 52-col. 24, line 18), the newly

generated address definition including some components based upon the

corresponding predetermined rule definition and the corresponding conditions (see

Taylor et al., col. 24, lines 19-40). It would have been obvious to one having ordinary

skill in the art at the time of the invention to modify Holleran et al. to automatically

generating a new address definition based upon the corresponding predetermined rule

definition and corresponding conditions at the second device, the newly generated

address definition including some components based upon the corresponding

predetermined rule definition and the corresponding conditions in order to provide an

electronic address book which allows information to be efficiently sent to users of both

electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

19.   As per claim 2, the above-mentioned motivation of claim 1 applies fully in order to

combine Holleran et al. and Taylor et al. Taylor et al. and Holleran et al. teach a method

of flexibly managing addresses for a communication system, wherein the addresses

include e-mail addresses, document folders, telephone number and fax numbers (see

Taylor et al., column 10, lines 28-34).

20.   As per claim 12, Holleran et al. teaches a system for flexibly managing

addresses for a communication system, comprising: a third device sending a re quest

for an address definition for use with a predetermined operation; a second device

connected to said third device for receiving the request for the address definition and

sending the request for the address definition (see Holleran et al., col. 3, lines 26-52);

and a first device connected to said second device for returning the address definition

containing a plurality of components to said second device in response to the address

definition request (see Holleran et al., col. 5, lines 40-64), said first device further

including an address maintenance unit for maintaining address information (see

Holleran et al., col. 4, line 55-col. 5, line 3); wherein said second device obtaining a

corresponding predetermined rule definition for the address definition to generate a new

address (see Holleran et al., col. 8, lines 1-20) and automatically generating a new

address definition including the new address based upon the corresponding

predetermined rule definition (see Holleran et al., col. 8, lines 46-65), said second

device returning the newly generated address definition including the new address to

said third device (see Holleran et al., col. 9, lines 13-23). But fails to teach wherein said

second device obtaining predetermined conditions for the address definition to generate

a new address, the newly generated address including some components based upon

the corresponding predetermined rule definition and the corresponding conditions.

However, Taylor et al. teaches wherein said second device obtaining predetermined

conditions for the address definition to generate a new address (see Taylor et al., col.

23, line 52-col. 24, line 18), the newly generated address including some components

based upon the corresponding predetermined rule definition and the corresponding

conditions (see Taylor et al., col. 24, lines 19-40). It would have been obvious to one

having ordinary skill in the art at the time of the invention to modify Holleran et al. to

wherein said second device obtaining predetermined conditions for the address

definition to generate a new address, the newly generated address including some

components based upon the corresponding predetermined rule definition and the

corresponding conditions in order to provide an electronic address book which allows

information to be efficiently sent to users of both electronic mail and facsimile

transmission (see Taylor et al., col. 3, lines 11-24).

21.   As per claim 22, Holleran et al. teaches a computer readable medium storing

computer executable instructions for performing the task of flexibly managing addresses

for a communication system, the computer executable instructions comprising the steps

of: requesting an address definition from a second device to a first device; returning the

address definition containing a plurality of components to the second device from the

first device (see Holleran et al., col. 5, lines 40-64); obtaining a corresponding

predetermined rule definition for the address definition to generate a new address (see

Holleran et al., col. 8, lines 1-20); automatically generating a new address definition

including the new address based upon the corresponding predetermined rule definition

at the second device (see Holleran et al., col. 8, lines 46-65). But fails to teach obtaining

a corresponding condition for the address definition to generate a new address, the

newly generated address including some components based upon the corresponding

predetermined rule definition and the corresponding condition; returning the newly

generated address definition including the new address from the second device to the

first device, the address definition each has a unique ID; determining whether or not an

ID already exists; storing the newly generated address if the ID does not exist; and

replacing information with the newly generated address if the ID exists. However, Taylor

et al. teaches obtaining a corresponding predetermined rule definition and a

corresponding condition for the address definition to generate a new address (see

Taylor et al., col. 23, line 52-col. 24, line 18), the newly generated address including

some components based upon the corresponding predetermined rule definition and the

corresponding condition (see Taylor et al., col. 24, lines 19-40); returning the newly

generated address definition including the new address from the second device to the

first device, the address definition each has a unique ID; determining whether or not an

ID already exists; storing the newly generated address if the ID does not exist; and

replacing information with the newly generated address if the ID exists (see Taylor et

al., col. 29, lines 18-30). It would have been obvious to one having ordinary skill in the

art at the time of the invention to modify Holleran et al. to obtaining a corresponding

predetermined rule definition and a corresponding condition for the address definition to

generate a new address, the newly generated address including some components

based upon the corresponding predetermined rule definition and the corresponding

condition; returning the newly generated address definition including the new address

from the second device to the first device, the address definition each has a unique ID;

determining whether or not an ID already exists; storing the newly generated address if

the ID does not exist; and replacing information with the newly generated address if the

ID exists in order to provide an electronic address book which allows information to be

efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et

al., col. 3, lines 11-24).

22.   Claims 3, 4, 10, and 11 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Holleran et al. and Taylor et al. as applied to claim 1 above, and

further in view of Krishnaswamy et al. (5,999,525).

23.   As per claim 3, Holleran et al. and Taylor et al. teach the mentioned limitations of

claim 1 above but fail to teach wherein the first device is an existing user account

management unit for user account information. However, Krishnaswamy et al. teaches

wherein the first device is an existing user account management unit for user account

information (see Krishnaswamy et al., column 23, lines 37-47). It would have been

obvious to one having ordinary skill in the art at the time of the invention to modify

Taylor et al. and Holleran et al. to wherein the first device is an existing user account

management unit for user account information in order to attach individual systems for

billing, provisioning, directory services, messaging services such as voice messaging

via a communication link (see Krishnaswamy et al., col. 23, lines 23-36).

24.   As per claims 4, 10, and 11, the above-mentioned motivation of claim 3 applies

fully in order to combine Holleran et al., Taylor et al, and Krishnaswamy et al.

25.   As per claim 4, Holleran et al., Taylor et al., and Krishnaswamy et al. teach an

address maintenance unit that corresponds to the existing user account management

unit for managing address information (see Krishnaswamy et al., column 23, lines 37-

47).

26.   As per claim 10, Holleran et al., Taylor et al., and Krishnaswamy et al. teach

wherein said generating the new address definition is performed prior to said requesting

the address definition (see Krishnaswamy et al., column 108, lines 21-32).

27.   As per claim 11, Holleran et al., Taylor et al., and Krishnaswamy et al. teach

wherein the address definition each has a unique ID and further comprises additional

steps of determining whether or not an ID already exists; storing the newly generated

address if the ID does not exist; and replacing information with the newly generated

address if the ID exists (see Krishnaswamy et al., column 102, lines 50-67).

28.   Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Krishnaswamy et al., Taylor et al., and Holleran et al. as applied to claims 1 and 4

above, and further in view of Ouchi (5,978,836).

29.   As per claim 5, Krishnaswamy et al., Taylor et al., and Holleran et al. teach the

limitations of claims 1 and 4 as described above but fail to teach wherein the address

maintenance unit manages delivery methods by adding a new delivery method. Ouchi

however teaches wherein the address maintenance unit manages delivery methods by

adding a new delivery method (column 12, lines 46-65). It would have been obvious to

one having ordinary skill in the art at the time of the invention to modify the above

limitation to add wherein the address maintenance unit manages delivery methods by

adding a new delivery method in order to go off route and capture the optimal route of

transmission.

30.   As per claim 6, Krishnaswamy et al., Taylor et al., and Holleran et al. teach the

limitations of claims 1, 4, and 5 as described above but fail to teach wherein the new

delivery method is specified in the rule definition. Ouchi however teaches wherein the

new delivery method is specified in the rule definition (column 8, lines 13-31). It would

have been obvious to one having ordinary skill in the art at the time of the invention to

modify the above limitation to add wherein the new delivery method is specified in the

rule definition in order to insure that the value for the active document is unique.

31.   As per claim 7, Ouchi, Holleran et al., Taylor et al., and Krishnaswamy et al.

teach the limitations of claims 1, 4, 5, and 6 as described above but Ouchi, Taylor et al.,

and Holleran et al. fail to teach wherein the rule definition further includes or the address

maintenance unit additionally manages an ID value, a Source value, a Condition value,

a Name Generation Method value, and a Type Generation Method value.

Krishnaswamy et al., however teaches wherein the rule definition further includes or the

address maintenance unit additionally manages an ID value, a Source value, a

Condition value, a Name Generation Method value, and a Type Generation Method

value (column 99, line 58-column 101, line 16: wherein VNET numbers serve the

function of a Condition value, unique ID serves the function of an ID value, IP address

serves the function of a Source value, a Name Generation Method value, and a Type

Generation Method value). It would have been obvious to one having ordinary skill in

the art at the time of the invention to modify the above limitation to add wherein the rule

definition further includes or the address maintenance unit additionally manages an ID

value, a Source value, a Condition value, a Name Generation Method value, and a

Type Generation Method value in order to allow an user to register his/her computer as "on-line" and available to receive calls.

32.   As per claim 8, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1 and 4 as described above but fail to teach wherein the address maintenance unit manages delivery methods by deleting an existing delivery method. Ouchi however teaches wherein the address maintenance unit manages delivery methods by deleting an existing delivery method (column 6, line 48-column 7, line 7). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit manages delivery methods by deleting an existing delivery method in order to permit more than one concurrent use of a workflow route.

33.   As per claim 9, Ouchi, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1 and 4, as described above but Ouchi, Taylor et al., and Holleran et al. fail to teach wherein the address maintenance unit updates the address information based upon the user account information. Krishnaswamy et al. however teaches wherein the address maintenance unit updates the address information based upon the user account information (column 41, lines 27-35). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit updates the address information based upon the user account information because cache copies must be refreshed when the version is out of date.

34.   Claims 13-21 have similar limitations as to claims 1-12 and 22 above; therefore,

they are being rejected under the same rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ranodhi Serrao whose telephone number is (571)272-

7967. The examiner can normally be reached on 8:00-4:30pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

/R. N. S./

Examiner, Art Unit 2141

3/21/2008

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2144